

RECEIVED
CENTRAL FAX CENTER

DEC 02 2009

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-08)

Approved for use through 07/31/2012. OMB 0851-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number	Filed
		10/828,531	April 15, 2004
		First Named Inventor	
CHEUNG et al.		Art Unit	Examiner
2615		BLAIR, KILE O.	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 32,947 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			


Signature

C. Douglass Thomas

Typed or printed name

650-903-9200

Telephone number

12/2/09

Date

This collection of information is required by 38 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9198 and select option 2.

DEC 02 2009

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: CHEUNG et al.

Attorney Docket No.: IPVBP003

Application No.: 10/826,531

Examiner: BLAIR, KILE O.

Filed: April 15, 2004

Group: 2815

Title: DIRECTIONAL SPEAKER FOR
PORTABLE ELECTRONIC DEVICE

CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence is being transmitted by facsimile to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 2, 2009.

Signed: Patricia Tate

Printed Name: Patricia Tate

PRE-APPEAL BRIEF

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action dated July 9, 2009, Applicants appeal the rejection and submit this Pre-Appeal Brief.

In the final Office Action, the Examiner rejected claims 13-25 under 35 U.S.C. §103(a). These rejections are fully traversed below. Claims 13-21 remain pending. Reconsideration of the application and withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

ENTRY OF AMENDMENTS

On August 28, 2009 Applicants filed Amendment E to provide minimal clarifications to a few claims, but the Examiner without any reasonable basis refused to enter the Amendment E. Submitted concurrently herewith is Amendment F which merely cancels claims 22-25 from the application.

REJECTION OF CLAIMS 13-21 UNDER 35 USC 103(a)

In the Office Action, the Examiner rejected claims 13-18 under 35 USC 103(a) as being unpatentable over Kim, U.S. Patent No. 6,512,826, in view of Breed et al., U.S.

Appln. No. 10/826,531

1

Docket No. IPVBP003

PATENT

Patent Pub. No. 2001/0038698; rejected claims 19 and 21 under 35 USC 103(a) as being unpatentable over Kim in view of Breed et al. and further in view of Carmi et al., U.S. Patent Pub. No. 2003/0174242 A1; rejected claim 20 under 35 USC 103(a) as being unpatentable over Kim in view of Breed et al. and further in view of Freadman, U.S. Patent No. 5,481,616; and rejected claims 22-25 under 35 USC 103(a) as being unpatentable over Zlotnick, U.S. Patent Pub. No. 2004/0114772. Applicants respectfully disagree.

Claim 13

Claim 13 pertains to a peripheral apparatus for an electronic device. The peripheral apparatus includes a directional speaker that provides ultrasonic sound output, and a controller operatively connected to the directional speaker. The controller operates to supply signals to the directional speaker so that the ultrasonic sound is output by the directional speaker. More particularly, among other things, claim 13 recites:

wherein the electronic device is a personal, hand-held wireless communication device, and said peripheral apparatus is configured to be removeably connected to the personal, hand-held wireless communication device,

wherein said peripheral apparatus is portable and able to be hand-held, and

wherein while said peripheral apparatus is connected to the personal, hand-held wireless communication system, the personal, hand-held wireless communication device with said peripheral apparatus remain portable and hand-held.

In contrast, Kim describes a hand-free kit. The kit has a main body, a connector member and a shaft member. The shaft member connects the main body and the connector member so as to permit the main body to rotate relative to the connector member. The connector member (i.e., connector member 420) connects to an external power source in a cigar portion.

As noted above, among other things, claim 13 recites that "while said peripheral apparatus is connected to the personal, hand-held wireless communication system, the personal, hand-held wireless communication device with said peripheral apparatus remain portable and hand-held." Clearly, Kim fails to teach or suggest this feature of

PATENT

claim 13. The hand-free kit 400 shown in Fig. 3 and elsewhere in Kim has a connector member 420 that serves to connect to a power source via a cigar portion. Kim, col. 4, lines 30-35. See also Kim, col. 5, lines 11-35. Consequently, for the hand-free kit disclosed in Kim to operate, it must be plugged into the cigar portion (i.e., lighter receptacle). Surely then, the hand-free kit in Kim cannot be considered to be portable and hand-held when connected. Moreover, to suggest otherwise would be contrary to the objectives of Kim. The connector member 420 in Kim is especially made for being inserted into a cigar portion provided within a car. The main body 410 is also configured such that it can rotate about the connector member 420. Through such mechanical rotation, a speaker portion 417 can be directed towards a person in the car. The cigar portion is thus an essential aspect of the hand-free kit 400; any argument avoiding or ignoring such an aspect of Kim would be improper.

On page 3 of the Office Action, the Examiner does recognize that Kim's speaker 417 is not taught as being able to provide ultrasonic output. However, in an effort to overcome this deficiency of Kim, the Examiner combines Breed et al. with Kim. Applicants submit that the proposed combination of references is improper as there is no motivation, hint or suggestion for the combination, nor is there any reasonable rationale for making the combination.

The speakers in Breed et al. are not part of a hand-held audio output device. Instead, the speakers are associated with a vehicle. Fig. 5A, for example, illustrates sound generating units 281, 282, 283 and 284 at different locations internal to the vehicle and used by an entertainment system 280 of the vehicle. E.g., para. [0132]. As such, Breed et al. fails to teach or suggest the electronic device of claim 1 which is a personal, hand-held wireless communication device.

The hand-free kit 400 in Kim has a speaker 417 and can only provide some directionality through a mechanical rotational movement of the main body 410 relative to the connector member 420. The sound generating units 281-284 of Breed et al. are dispersed at different locations in a vehicle (e.g., car), while the hand-free kit 400 of Kim is self-contained and designed to connect into a cigar portion in a car. Hence, there is no rational basis for someone skilled in the art to use the sound generating units 281-284 of Breed et al. with the self-contained hand-free kit 400 of Kim. As such, the Office

PATENT

Action's cited reasoning for combining Kim and Breed et al. has been derived using impermissible hindsight reconstruction. There is no motivation or suggestion to combine the prior art references as proposed in the Office Action. Rather, such a motivation has been given by the Applicants who first realized the problems presented and discovered a viable solution. Using the Applicant's teaching to modify a prior art reference is an impermissible use of "hindsight." *In re Zurko*, 111 F.3d 887, 42 USPQ2d 1476 (Fed. Cir. 1997). Accordingly, Applicants submit, notwithstanding the Examiner's assertion to the contrary, that there is no reasonable rationale why anyone skilled in the art would reasonably seek to combine Kim and Breed et al. "A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1397 (2007).

Even if the hand-free kit 400 of Kim could somehow be combined with the sound generating units 281-284 of Breed et al. as proposed by the Examiner, the hand-free kit 400 would necessarily become even further non-portable and further non-hand-held.

In addition, although the Examiner points to paragraph [0144] of Breed et al. as allegedly teaching a directional speaker, this portion of Breed et al. is far from being clear. The paragraph refers to "directional speaker" yet references FIG. 10 whose ultrasonic transducers 231, 232 and 233 determine the location of the driver's head and control the pointing direction of the microphone 355. These ultrasonic transducers 231, 232 and 233 are not designed to be directional speakers to generate audio outputs. Instead, the audio speaker 357 shown in FIG. 10 is connected to the phone system 359 and does not seem to be able to produce ultrasonic sound output which results in audio sound in a particular direction of a user sitting in the vehicle.

Accordingly, it is submitted that Kim in view of Breed et al. fails to teach or suggest the peripheral apparatus recited in claim 13. Also, claims 14 and 15 depend from claim 13 and are, therefore, patentably distinct from Kim in view of Breed et al. for at least the same reasons.

Claim 16

Claim 16 pertains to a peripheral device for a hand-held computing device. The peripheral device is itself a hand-held device and includes a housing with a directional

PATENT

speaker and a controller. The directional speaker is configured to provide ultrasonic sound output in a particular direction, wherein the ultrasonic sound output by the directional speaker can result in audio sound in the particular direction for a user of said computing device. The controller is connected to the directional speaker and operates to supply signals to the directional speaker so that the ultrasonic sound is output by the directional speaker. The peripheral device can also include "a port connector configured to assist with coupling said peripheral device to the computing device so that said computing device can drive said directional speaker to produce the audio sound." Also, similar to claim 13, claim 16 specifically recites: "wherein said peripheral device is a hand-held device." Breed et al. is not hand-held and the combination of Kim and Breed et al. would not be hand-held and indeed Breed et al. would teach against such combination being hand-held.

For at least the reasons noted above, Kim and Breed et al., alone or in combination, are unable to teach or suggest the numerous features of claim 16.

Therefore, it is submitted that Kim in view of Breed et al. fails to teach or suggest the peripheral device recited in claim 16. Also, claims 17-21 depend from claim 16 and are, therefore, patentably distinct from Kim in view of Breed et al. for at least the same reasons.

CONCLUSION

Based on the foregoing, it is submitted that claims 13-21 are patentably distinct from Kim, alone or in combination with Breed et al. The other cited references, Carmi, Freedman and Zlotnick, even if combinable with Kim and Breed et al, are not able to overcome the deficiencies of Kim and Breed et al. noted above. Accordingly, it is respectfully requested that the Examiner withdraw the rejections under 35 USC 103(a).

Reconsideration of the application and instructions directing the Examiner to withdraw the pending rejections under 35 USC 103(a) are earnestly solicited.

Respectfully submitted,

/C. Douglass Thomas/
C. Douglass Thomas
Reg. No. 32,947

(650) 903-9200 x103